REMARKS

A. Introduction

Claims 1-26 are pending and under consideration in the application.

In the Office Action of July 26, 2007 ("the Office Action"), claims 1-26 were rejected as obvious. The rejection was made final.

In response, no claims have been slightly amended as to form, but the scope of the original claims has not been altered, and no new matter is presented.

B. Rejection under 35 USC §103

1. Claims 1, and 3-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent Publication 2003/0161988 to Hwang and U.S. Patent Publication 2003/0044719 to Katoh. Applicants traverse these rejections for at least the following reasons.

Regarding independent claims 1 and 14, the Examiner acknowledges that Hwang does not teach "a first lower dielectrics layer and a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting" and "a first upper dielectrics layer and a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting," as recited in independent claims 1 and 14.

In attempt to remedy the Hwang deficiency, the Examiner contends that "Katoh teaches different dielectric materials for forming the dielectric layers and their portions, para [0100]." *See* the Office Action, page 3. The Examiner concludes that "[i]t would have been obvious…to modify the dielectric layer of Hwang to include not only ZnS and Si_2 but also Si_3N_4 because it has already been taught in Katoh that this material could be used in combination, para [0101]…[and] [t]he modification would have been obvious because of the benefit of Si_3N_4 in preventing chemical reaction of the first compounds of the dielectric layers of the recording layer." *See* the Office Action, pages 3 and 4. However, Hwang and Katoh, individually and combined, do not disclose the Applicants' invention as recited in independent claims 1 and 14, and Applicants traverse these rejections for at least the following reasons.

The Examiner does not appear to give any weight to the limitations: first and second upper dielectric layers and first and second lower dielectric layers, as recited in independent claims 1 and 14. These are distinct layers of different materials that positively effect each other. In any case, neither Hwang nor Katoh disclose or suggest these elements. Hwang is limited to a single lower dielectric layer and a single upper dielectric layer. *See* Katoh, fig. 1. Likewise, Katoh is limited to a single lower dielectric layer and a single upper dielectric layer. *See* Katoh, fig. 1. This is not the same as "a first lower dielectrics layer and a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting" and "a first upper dielectrics layer and a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting," as recited in independent claims 1 and 14. In other words, it is not possible for any of the single layers of either Hwang or Katoh to inhibit itself from reacting.

Further, the Examiner's combination of Hwang and Katoh is clearly the product of impermissible hindsight. It appears that Katoh was only referenced because Katoh provides a random listing of materials that may be used to form a dielectric layer. Specifically, Katoh paragraph 100 merely provides "nitrides such as Si_3N_4" and "sulfides such as ZnS." Katoh paragraph 101 provides that these material may be used "individually or in combination." Katoh provides no further discussion of these materials and, therefore, fails to provide any motivation to select any one of these materials, and especially not a specific combination thereof. While the Examiner argues that one would be motivated to select these materials to "prevent[] chemical reaction of the first compounds of the dielectric layers with the recording layer," the Examiner provides no support for this argument and this alleged benefit is not found in any of the references of record. Moreover, even if these references could be combined, and motivation existed to do so, such a hypothetical combination would not provide the invention as recited.

As pointed out above, none of the references of record provide multiple upper and lower dielectric layers. Thus, even if the Katoh materials were employed in Hwang, the result would not yield additional upper and lower dielectric layers, as recited in independent claims 1 and 14. At best, the result would be a mixture of material that is not capable of inhibiting itself from reacting with a recording layer. In any case, the Examiner has not articulated why one would be

motivated to: (1) use the Katoh materials in Hwang; and (2) employ multiple upper and lower dielectric layers. Clearly, the Examiner is using impermissible hindsight.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;
(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
(D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). (Emphasis added).

In addition to the above deficiencies, the Examiner repeatedly employs Katoh to reject the majority of dependent claims, but fails to provide any motivation to incorporate the Katoh elements into the primary reference, Hwang. For instance, in attempt to reject claims 5 and 18, the Examiner alleges Katoh employs a "phase change recording layer." *See* the Office Action, page 4. Further, the Examiner alleges that Katoh teaches specific material percentages and thicknesses in attempt to reject other claims. Still further, in attempt to reject claims 11 and 24, the Examiner alleges that Katoh a light transmissive sheet and an adhesive layer. Notably, the Examiner provides no logic or other articulated reasoning as to why one would be motivated to employ this Katoh element into the primary reference, Hwang. Thus, these rejections under U.S.C. 103 are flawed.

Accordingly, Hwang and Katoh, both individually and combination, fail meet all of the limitations recited in claims 1-26. Therefore, the rejections of claims 1-26 under 35 U.S.C. §103(a) are improper, and withdrawal of these rejections and allowance of these claims are earnestly solicited.

2. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable in view of Hwang, Katoh and U.S. Patent 6,218,292 to Foote. Applicants traverse this rejection for at least the following reason.

The Examiner acknowledges that neither Hwang nor Katoh disclose or suggest "wherein extinction coefficients k of materials that constitute the upper dielectrics layer and the lower dielectrics layer satisfy relationship of $0 < k \leq 3$," as recited in claim 2. In attempt to remedy the

Hwang-Katoh deficiency, the Examiner contends that Foote teaches "the optical recording medium according to claim 1, wherein the extinction coefficients k of materials that constitute the upper dielectrics layer and the lower dielectrics layer satisfy relationship of $0 < k \leq 3$ (extinction coefficient, k = 1 col 3 lines 59-66)." *See* the Office Action, page 7. The Examiner concludes that "[i]t would have been obvious…to modify the dielectric layer so that the extinction coefficient would be in a specified range…[and] [t]he modification would have been obvious because of the benefit of a controlled extinction coefficient with respect to reflection." *Id*. It is not clear how having an extinction coefficient in a specified range is beneficial, or what the benefit is of a controlled extinction coefficient, as argued by the Examiner. The motivation of record is simply not reasonable. One would not have incorporated the teachings of Foote into Hwang merely to have an extinction coefficient in a specified range or a controlled extinction coefficient, as argued by the Examiner.

Accordingly, the rejection of claim 2 is flawed. Hwang, Katohn and Foote, individually or in combination, fail to meet all of the limitations recited in claim 2. Therefore, the rejection of claim 2 under 35 U.S.C. §103(a) is improper, and withdrawal of this rejection and allowance of this claim are earnestly solicited.

C. Finality

The Examiner neglected to reject claims 15 and 21. Applicants respectfully request examination of every pending claim on the merits.

Applicants object to the Examiner's statement that "it is incumbent upon the applicant to analyze the prior art document(s) in it's/their entirety since other area of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record." *See* the Office Action, page 7. The Examiner appears to have misinterpreted MPEP 2141.02, which provides that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *Id*. Notably, MPEP 2141.02 provides Examination guidelines for employing 35 U.S.C. 103 and requires an Examiner to consider portions of the prior art that teach away from the claimed invention. This section does not shift the duty of examination to the applicant and the Board of Patent Appeals and Interferences (BPAI) has reversed obviousness rejections if the office action provides no "articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness." *See* M. Chandler and M. Spain, Appeal 2007-3120 (BPAI, May 30, 2008) (citing KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)). MPEP §706.07 states that "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing," and "in making the final rejection…any such grounds relied on…must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal."

D. Conclusion

In view of the foregoing, it is submitted that claims 1-26 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
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